



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/161,478	09/28/98	TOYOSAWA	K 1035-204

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MM92/1221

EXAMINER

GRAYBILL, D

ART UNIT

PAPER NUMBER

2814

DATE MAILED: 12/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/161,478

Applicant(s)

TOYOSAWA ET AL.

Examiner

David E Graybill

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 2814

Claims 20-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 4, 6, 7, 9-11, 13, 15 and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by applicant's admitted prior art.

At page 2, line 9 to page 16, line 8; and page 21, line 19 to page 23, line 4, applicant discloses that all of the essential elements of claims 1, 2, 4, 6, 7, 9-11, 13, 15 and 18 are conventional.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 2814

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art.

Applicant does not appear to explicitly teach the particular claimed panel size. Notwithstanding, it would have been an obvious matter of design choice bounded by well known manufacturing constraints and ascertainable by routine experimentation and optimization to choose this particular size because applicant has not disclosed that the size is for a particular unobvious purpose, produces an unexpected result, or is otherwise critical, and it appears prima facie that the product would possess utility using another dimension. Moreover, it has been held that limitations directed to size are

Art Unit: 2814

prima facie obvious absent a disclosure that the limitations are for a particular unobvious purpose, produce an unexpected result, or are otherwise critical. See, for example, In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984); In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as applied to claims 1, 2, 4, 6, 7, 9-11, 13, 15 and 18 supra, and further in combination with Kimura (5767571).

As cited, in particular, at page 3, lines 20-22, applicant teaches wherein the periphery of portions at which the tape carrier and the driving semiconductor elements have been electrically connected is covered with resin 115 having an insulating property in a manner so as to allow the edge of the resin to make an angle of not more than 70° with the upper surface of the first insulating protective film. Although applicant does not appear to literally teach as conventional the claimed resin angle, it is noted that applicant teaches this angle with reference to Fig.1(b), and the prior art Fig.7(b) illustrates an identical resin angle.

Also, applicant does not appear to explicitly teach as conventional a liquid resin. Nonetheless, at column 7, lines 1-3 and 60-65, Kimura teaches a liquid resin 5, and further teaches wherein the periphery of portions at which a tape carrier 3 and driving semiconductor elements 1 have been electrically connected is covered with liquid resin 5 having an insulating property in a manner so as to allow the edge of the resin to make an angle of not more than 70° with the upper surface of the first insulating protective film. Moreover, it would have been obvious to combine the product of Kimura with the product of applicant's admitted prior art because it would reduce package size.

Claims 3, 8, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as applied to claims 1, 2, 4, 6, 7, 9-11, 13, 15 and 18 supra, and further in combination with Miyamura (5441918).

Applicant does not appear to explicitly teach as conventional wherein the solder resist of the first insulating film contains a filler at the particular claimed wt%. Nevertheless, Miyamura teaches this limitation at column 5, lines 39-51. In addition, it would have been obvious to combine the product of Morisaki with the product of applicant's admitted

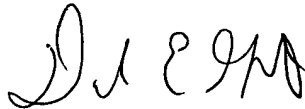
Art Unit: 2814

prior art because it would provide a solder resist having desirable properties.

Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to the Customer Service Office, TC 2800, 703/306-3329.

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/305-3431.



David E. Graybill
Primary Examiner
Art Unit 2814

D.G.